

JPW



PATENT  
Customer No. 22,852  
Attorney Docket No. 9404.0015-02

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
)  
Peter C. Appelbaum *et al.* ) Group Art Unit: 1625  
)  
Serial No.: 10/685,823 ) Examiner: D. Margaret Seaman  
)  
Filed: October 15, 2003 )  
)  
For: METHODS OF USE OF )  
FLUOROQUINOLONE )  
COMPOUNDS AGAINST )  
CIPROFLOXACIN-RESISTANT )  
AND CIPROFLOXACIN- )  
SENSITIVE BACTERIA )

**Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

In response to the Office action mailed May 6, 2004, Applicants submit the following remarks. Because the shortened statutory period for response runs to June 6, 2004, this response is timely filed.

The Office action imposes a restriction requirement. According to the Examiner, pending claims 1-20, 24-26 and 30-35 represent four distinct inventions:

Group I: claims 1-2, 5-7, 9, 11 and 24-26, drawn to a method for modulating metabolism of ciprofloxacin-resistant *Streptococcus pneumoniae*, classified in class 514, subclass 312+;

Group II: claims 3-4, 8, 10 and 17-19, drawn to a method for treating or preventing a bacterial infection by ciprofloxacin-resistant *Streptococcus pneumoniae*, classified in class 514, subclass 312+;

Group III: claims 12, 13, 16-18, 20 and 30-32, drawn to a method for modulating metabolism of ciprofloxacin-sensitive *Streptococcus pneumoniae*, classified in class 514, subclass 312+; and

Group II: claims 14, 15, 19 and 33-35, drawn to a method for treating or preventing a bacterial infection by ciprofloxacin-sensitive *Streptococcus pneumoniae*, classified in class 514, subclass 312+.

Office action, page 2.

Applicants elect, with traverse, Group I, directed to claims 1-2, 5-7, 9, 11 and 24-26.

It is noted that claims 27-29 were not listed in any Group. Clarification as to the grouping of claims 27-29 is requested.

Applicants traverse the rejection on the following grounds. Restriction is proper when two criteria are met. First, the inventions must be independent or distinct as claimed. Second, there must be a serious burden on the Examiner. "If the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803. The Examiner has not shown that these criteria are met.

Each of the allegedly separate and distinct inventions falls within class 514, subclass 312+. The Examiner's search of the art relative to elected claims 1-2, 5-7, 9, 11 and 24-26 will also constitute a search of the subject matter of the claims 3, 4, 8, 10,

12-20, and 27-35. Consequently, there is no additional burden on the Examiner associated with examining all pending claims. In the absence of a serious burden, the restriction requirement is improper and the Examiner should withdraw it.

For these reasons, Applicants request that the Examiner reconsider and withdraw the restriction requirement, and examine the full scope of claims 1-20 and 24-35 in this application. If, however, the Examiner maintains the restriction requirement, Applicants request that the requirement be made final so that they may file a petition to the Commissioner of Patents seeking review of that decision.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 1, 2004

By: \_\_\_\_\_



Steven P. O'Connor  
Reg. No. 41,225